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DAE

PATENT
P56382

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JOO-HYOUNG LEE *et al.*

Serial No.: 09/885,100

Examiner: TRAN, TRANG U.

Filed: 21 June 2001

Art Unit: 2614

For: DISPLAYING APPARATUS AND METHOD FOR CONTROLLING THE
SAME

PETITION UNDER 37 C.F.R. §1.181

Paper No. 18

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition from the Examiner's issuance of a Notice of Non-Compliant Amendment (37 C.F.R. §1.121) dated 17 June 2005 (Paper No. 20050610) in response to the Amendment filed on 19 May 2005, in that the Examiner's statement in the Notice is inconsistent with the agreement reached during the telephone interview with Examiner Tran and Supervisory Primary Examiner, Mr. John Miller, on Friday, 4 March 2005, and as reasons therefor Applicants state that:

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Date: 7/15/05
I.D.: REB/kf

STATEMENT OF FACTS

1. On 20 May 2004, a final Office action was issued (Paper No. 8).
2. On 14 July 2004, Applicants filed an Amendment After Final in response to the final Office action mailed on 20 May 2004.
3. On 3 November 2004, an Office action was issued (Paper Non. 20041021) in which the finality of the previous Office action was withdrawn.
4. On 30 December 2004, Applicants filed a Request for Clarification and Restart of Period for Response (Paper No. 11) requesting clarification of the several inconsistencies found by Applicants in the non-final Office action mailed on 3 November 2004 (Paper No. 20041021).
5. On 2 February 2005, in the absence of any correspondence from the Examiner in response to Applicant's Request for Clarification of 30 December 2004, Applicant's undersigned attorney telephoned the Examiner.
6. On 2 February 2005, Applicants filed an Interview Summary Record (Paper No. 12) based upon the Applicants' understanding of the telephone discussion with the Examiner, Ms. Trang U. Tran, and a separate telephone discussion with the Examiner's supervisor, Mr. John W. Miller. Applicants' understanding was that, the Applicants' Request for Clarification and Restart of Period for Response (Paper No. 11) filed in the U.S. Patent & Trademark Office on 30 December 2004 in response to the Office action mailed on 3 November 2004 (Paper No. 20041021) had not yet been scanned, that the Request for Clarification had not yet been placed in the file, and that

the Examiner therefore had not yet examined the Request for Clarification and Restart of Period for Response filed on 30 December 2004.

7. On 3 March 2005, in the absence of any correspondence from the Examiner in response to Applicant's Request for Clarification of 30 December 2004 (Paper No. 11), Applicant's undersigned attorney again telephoned the Examiner.
8. On 3 March 2005, Applicants filed an Interview Summary Record (Paper No. 13) based upon the Applicants' understanding of the telephone discussion with the Examiner Tran. It was Applicants' understanding that the Examiner had not yet received the Applicants' Request for Clarification and Restart of Period for Response (Paper Non. 11) filed in the U.S. Patent & Trademark Office on 30 December 2004 in response to the Office action mailed on 3 November 2004 (Paper No. 20041021), and that the Office file for this application was not the Examiner's possession. It was further understood that, although the Request for Clarification filed on 30 December 2004 could be obtained from the USPTO Patent Application Information Retrieval system, according to the Examiner, without the Office file, the Examiner could not process Applicant's Request for Clarification filed on 30 December 2004.
9. On 4 March 2005, subsequent to the telephone discussions with the Examiner on 3 March 2005, Applicants' undersigned attorney had several telephone discussions with Examiner Tran and the Examiner's supervisor, Mr. John W. Miller.
10. On 4 March 2005, Applicants filed an Interview Summary Record (Paper No. 14) based upon the Applicants' understanding of the telephone discussions with the

Examiner, Ms. Trang U. Tran and a separate telephone discussions with the Examiner's supervisor, Mr. John W. Miller. It was Applicants' understanding that, it appears that under the new internal system of the U.S. Patent & Trademark Office, the Applicants' Amendment After Final filed on 14 July 2004 (Paper No. 9) was never entered, and that the outstanding non-final Office action (Paper No. 20041021) dated 3 November 2004 was based upon the non-entry of the Amendment After Final.

11. It was and is also Applicant's understanding that the Legal Instrument Examiner had never entered the Amendment After Final filed on 14 July 2004 (Paper No. 9), but that the Patent Examiner determined that the final rejection was incorrect, that the arguments set forth in the Amendment After Final were correct, and that the examination should and would be re-opened on the merits. Subsequently, the Patent Examiner examined the then pending claims, despite the fact that the Amendment After Final filed on 14 July 2004 should have been entered.
12. It was agreed with the Examiner and the Supervisory Primary Examiner that Applicants would prepare and file an Amendment in response to the outstanding Office action (Paper No. 20041021), but with the understanding that the Amendment After Final filed on 14 July 2004 (Paper No. 9) had in fact been entered, and should have been entered as of the 4th of March 2005. In addition, it was understood that the period for response to the outstanding Office action (Paper No. 20041021) was reset to expire three months from 4 March 2005, that is, to and through June 2005.
13. On 19 May 2005, Applicants prepared and filed an Amendment (Paper No. 15) in

response to the non-final Office action mailed on 3 November 2004 (Paper No. 20041021), and in response to the telephone conference between the Examiner and the Applicants' undersigned attorney on 4 March 2005, during which conference the period for response to Paper No. 20041021 was restarted from the date of the telephone conference (4 March 2005).

14. On 17 June 2005, a Notice of Non-Compliant Amendment (37 C.F.R. §1.121) was issued (Paper No. 20050610). In the Detailed Action of Paper No. 20050610, the Examiner stated that **"there is no agreement in entering the Amendment After Final filed on 14 July 2004. Applicant was asked to file an Amendment in response to the outstanding Office action 9Paper No. 20041021) during the telephone conferences."**
15. The Examiner further stated that, "After considering the Amendment After Final dated July 13, 2004, the Examiner determined that the final Office action dated May 20, 2004 is incorrect and the finality of that Office was withdrawn. The subsequent non-final Office Action dated Nov. 3, 2004 was responsive to the **previous Amendment filed Feb. 20, 2004** but not the Amendment After Final filed on July 14, 2004. The After Final Amendment filed on July 14, 2004 **has not been entered and will not be entered**. Accordingly, the non-final Office Action dated Nov. 3, 2004 is correct and the period for respond to that Office Action will not be reset."

REMARKS

First, Applicants properly and timely responded to the final Office action mailed on 20 May 2004 (Paper No. 8) by filing an Amendment After Final (Paper No. 9) on 14 July 2004. The Examiner admitted, in the first paragraph of the non-final Office action (Paper No. 20041021), under the sub-title "Response to Amendment" that "Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn." Thus, the Office action mailed on 3 November 2004 was in response to the Applicants' Amendment After Final filed on 14 July 2004, which must have been entered because, as admitted by the Examiner, the finality of the Office action of 20 May 2004 (Paper No. 8) was withdrawn.

Therefore, the Examiner's statement set forth in the Notice of Non-Compliant Amendment (37 C.F.R. §1.121) dated 17 June 2005 (Paper No. 20050610), to that effect that "[t]he subsequent non-final Office Action dated Nov. 3, 2004 was responsive to the **previous Amendment filed Feb. 20, 2004** but not the Amendment After Final filed on July 14, 2004" does not make any sense because it is not consistent with the Examiner's previous statement that the finality of the Office action of 20 May 2004 (Paper No. 8) was withdrawn.

The Amendment After Final filed on 14 July 2005 should, therefore, be entered because the Examiner considered the Amendment After Final and withdrew the finality of the final Office action (Paper No. 8). In the latter regard, it is noted that the fifth paragraph

of MPEP §706.07(e) states that “[w]hen a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.”

Second, Applicants and the Examiners had three (3) telephone interviews on 2 February 2005, 3 March 2005 and 4 March 2005, and those interviews were recorded by Applicants in the Interview Summary Records filed on 2 February 2005, 3 March 2005 and 4 March 2005, respectively. In contrast, no Interview Summaries were issued by the Examiners relative to these three telephone interviews.

In the third telephone interview which took place on 4 March 2005 between Applicants’ undersigned attorney and the Examiner, Ms. Trang U. Tran and the Examiner’s supervisor, Mr. John W. Miller, it was agreed that Applicants would prepare and file an Amendment in response to the outstanding Office action (Paper No. 20041021), but with the understanding that the Amendment After Final filed on 14 July 2004 (Paper No. 9) should have been entered, and in fact had been entered as of the 4th of March 2005. In addition, it was agreed that the period for response to the outstanding Office action (Paper No. 20041021) would be reset to expire three months from 4 March 2005, that is, to and through 4 June 2005.

Applicants recorded this telephone interview in the Interview Summary Record of 4 March 2005, as filed in the U.S. Patent & Trademark Office on 4 March 2005. In the

Interview Summary Record, the Applicants respectfully requested the Examiner to immediately telephone Applicants' undersigned attorney if Applicants' understanding was incorrect.

After more than three (3) months from the filing of the Interview Summary Record, Applicants' attorney received no telephone call from the Examiner. Instead, Applicants received a Notice of Non-Compliant Amendment (37 C.F.R. §1.121) in which the Examiner alleged that "no agreement in entering the Amendment After Final filed on 14 July 2004" was reached, and that "Applicant was asked to file an Amendment in response to the outstanding Office action (Paper No. 20041021) during the telephone conferences."

In view of the above, it is submitted that the Examiner's statement set forth in the Office action mailed on 3 November 2004, that the finality of the final Office action of 20 May 2004 (Paper No. 8) was withdrawn in view of the Applicant's "request for reconsideration" (contained in the Amendment After final filed on 14 July 2005) is inconsistent with the Examiner's statement set forth in the Notice of Non-Compliant Amendment (37 C.F.R. §1.121) mailed on 17 June 2005, that the Office action mailed on 3 November 2004 was in response to the Amendment mailed on 20 February 2004. Furthermore, the Examiner's statement relative to the telephone interview on 4 March 2005 is untimely and is inconsistent with Applicants' Interview Summary Record filed on 4 March 2005. It is respectfully submitted that the inconsistencies and untimeliness which have been

exhibited by the Examiner during the prosecution of the application to date are extremely unfair to the Applicants.

RELIEF REQUESTED

In view of the above, the Commissioner is respectfully requested to direct the Examiner to:

- A. Strike-out the Notice of Non-Compliant Amendment (37 C.F.R. §1.121) mailed on 17 June 2005;
- B. Enter the Amendment After Final filed on 14 July 2005;
- C. Enter the Amendment filed on 19 May 2005;
- D. Conduct further examination based on the latter Amendment; and
- E. Grant such other and further relief as justice may require.

Respectfully submitted,



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